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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,933	10/16/2003	John Gavin MacDonald	KCX-665 (19232)	4589
22827 7590 02/27/2008 DORITY & MANNING, P.A. POST OFFICE BOX 1449 GREENVILLE, SC 29602-1449				
EXAMINER				
SILVERMAN, ERIC E				
ART UNIT		PAPER NUMBER		
1618				
MAIL DATE		DELIVERY MODE		
02/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/686,933

**Applicant(s)**

MACDONALD ET AL.

**Examiner**

ERIC E. SILVERMAN

**Art Unit**

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31, 35-48 and 50-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31, 35-48 and 50-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Applicants' response, filed 12/10/2007, has been received. Claims 31, 35 - 48, and 50 - 53 are pending in this action.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31, 38 and 43 – 47 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 40, 41, 47 – 53 of copending Application No. 10/686,938 for reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 31, 43, 50 and 53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 35 of U.S. Patent No. 7,141,518 for reasons of record.

### ***Response to Arguments***

Applicants' have agreed that a terminal disclaimer will be filed over both the '518 patent and the '938 application if the Office still requires such a filing when the claims are otherwise in condition for allowance. Until receipt of an acceptable terminal disclaimer, this rejection must be maintained.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 31, 35 – 42, 49, 50 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 1 186 854 to Honda et al for reasons of record and those discussed below.

#### ***1 Newly added claim 53***

Claim 53 requires that the colloidal particles consist essentially of silica or alumina coated silica. "Consists essentially of" limits the addition of materials that would alter the properties of the invention. In this case, the property is absorption of odor. The prior art particles, in addition to silica, contain titanium. The ability of the material to absorb odor stems from the presence of silica, which binds odor, the surface area, which provides an interface between the silica and the odiferous compound, and the pores, which provide a space to trap the odiferous compound. There is no reason to believe that the addition of titanium would interfere with this property; as such, the Honda particles are not excluded by the "consisting essentially of" language.

#### ***2 Response to arguments***

Applicants' arguments have been fully considered, but are not persuasive.

Applicants contend that the limitation that the silica particles are "configured to absorb one or more odorous compounds" raises the claim over the art. In response, the silica particles of the art have no structural differences from those of the claims. As such, they are understood to have the same properties. A composition and its properties are not separable.

Applicants' proceed to argue that Honda's nanoparticles are not silica. Applicants point to Honda's disclosure that certain properties of the material, such as its crystallinity, are not consistent with Honda's nanoparticles being a mixture of silica and titania. In response, the nanoparticles of Honda clearly contain oxides of silicon, or silica. That the crystalline properties have changed is not material. Silicon oxide is present, and that suffices to meet the claim limitations.

Applicants' proceed to argue that there is no evidence that Honda's particles have the required pore volume. The previous office action explained that because the size and surface area of the prior art particles is the same as the claimed particles, the pore volume is inherently identical. When the office explains why a feature is inherent, the burden shifts to Applicants to show with evidence why the feature is not inherent. This Applicants have failed to do. Applicants have merely argued that the Office's reasoning is improper. Argument is neither evidence, nor a substitute for evidence when evidence is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al for reasons of record.

Claims 44, 45, 46, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al. in view of WO 03/025067 to Beaverton for reasons of record.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al. in view of US 5,762,643 to Ray et al for reasons of record.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al in view of US 2002/0006425 to Takaoa et al for reasons of record.

### ***Response to Arguments***

Applicants' arguments with respect to all of the rejections under 35 USC 103(a) are essentially identical; the arguments have been fully considered, but are not persuasive. In each case, Applicants aver that the secondary references do not make up for the alleged deficiencies in Honda. These supposed deficiencies have been addressed.

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ERIC E. SILVERMAN** whose telephone number is (571)272-5549. The examiner can normally be reached on Monday to Thursday 7:00 am to 5:00 pm and Friday 7:00 am to noon.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571 272 0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Michael G. Hartley/  
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